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Dated: December 23, 2005

Signature:

(Monica T. Owens)

Docket No.: HO-P01981US1
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Robert L. Heston, Jr

Application No.: 09/900,281

Filed: July 6, 2001

Art Unit: 3629

For: METHOD AND SYSTEM FOR PERFORMING
LEGAL SERVICES OVER THE INTERNET

Examiner: J. A. Mooneyham

RESPONSE TO RESTRICTION REQUIREMENT

MS Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Examiner:

In response to the restriction requirement set forth in the Examiner's Office Action mailed August 23, 2005, Applicant hereby provisionally elects claims 26-30, defined in the Office Action as Group II, for continued examination, with traverse. Applicant respectfully requests reconsideration and withdrawal of the restriction requirement in light of the arguments set forth below.

Restriction requirements have been made between Claims 1-25 ("Group I"), Claims 26-30 ("Group II"), Claims 31-35 ("Group III"), Claims 36-40 ("Group IV") and Claims 41-45 ("Group V"), (collectively "the Groups"), on the basis that the Groups are related as subcombinations disclosed as usable together in a single combination.

The Commissioner may require restriction if two or more independent and distinct inventions are claimed in a single application (37 CFR 1.142(a)). In the present case, although the claimed subject matter may be classified in different classes, the inventions are not independent. Applicant believes the Groups provide alternate systems and methods for performing legal services on a network. For example, Group I sets forth, in part, systems and

methods for communicating, displaying, creating forms, populating forms, navigating, searching, authenticating, processing and otherwise manipulating various types of information unique to legal services. Groups II, III, IV and V provide methods for the same. Groups II, III, IV and V, however, are drawn more particularly to systems and methods, or critical elements of the systems and methods, set forth in Group I. The following nonexclusive list illustrate commonalities:

Groups I and II both receive and authenticate identifiers (namely, client identifiers and access identifiers).

Groups I and III both create electronic forms, and receive, store, and display information related to such electronic forms.

Groups I and IV both implement topical searches, retrieve legal information from the database and display search results.

Groups I and V both create and store navigation path records.

Groups II and III both retrieve and display client specific legal information.

Groups II and IV both retrieve and display legal information associated with a unique identifier (namely an access identifier, client identifier, topical identifier or tag identifier).

Groups II and V both respond to user's selection to display legal information associated with a unique identifier (namely, an access identifier, client identifier, electronic form name, tag identifier or topical identifier).

Groups III and IV both implement user's input of legal information into a program interface or form. Such information is also stored and displayed in Groups III and IV.

Groups III and V both retrieve information from a database and display such information (forms and navigation paths) to a client.

Groups IV and V both search for legal topic information associated with a tag identifier and record navigation paths explored during such searches. Groups IV and V also

retrieve information (path records and search results) from a database and dynamically display such information.

Thus, many of the methods, or elements of the methods, set forth in Groups II, III, IV and V are also set forth in Group I. Note, however, that the elements of the methods set forth in Groups II, III, IV and V are not necessarily set forth in their entirety in Group I. Similarly, the elements of the systems or methods set forth in Group 1 are not necessarily set forth in their entirety in Groups II, III, IV and V.


It is well settled that for a restriction to be proper, that there must be a serious burden on the examiner in searching the Groups. See, M.P.E.P. §803. Applicant believes that a reasonable search for the invention of the Groups would overlap as each are concerned with providing legal services over a network and, in doing so, use common systems and methods. The Groups, therefore, do not contain divergent subject matter. Applicant also notes that Groups I and II are classified in the same class, namely class 705. In light of these comments, Applicant believes that the inventions of the Groups do not place a serious burden on the Examiner in searching each of the inventions, and that restriction between the Groups is improper.

If the Examiner is aware of another method to make the product as claimed, using a process which is materially different from that set forth in the restricted claims, Applicant respectfully requests the Examiner to substantiate his position in greater detail. Otherwise, it is respectfully requested that the restriction requirement be withdrawn, and that each of claims 1-45 presently pending in this application be examined.

Please find payment for a three-month extension enclosed herein. Applicant believes no other fee is due with this response. However, if other fee is due, please charge our Deposit Account No. 06-2375, under Order No. HO-P01981US1 from which the undersigned is authorized to draw.

Dated: December 23, 2005

Respectfully submitted,

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